

### REMARKS

Claims 14-29 are in the application and stand currently amended.

Claims 1-13 are cancelled.

Favorable reconsideration is respectfully requested in view of the enclosed amendments and the following representations.

No new matter has been added. Support for the amendments is found in the original claims, specification, and drawings.

Applicant appreciates Examiner Snow's understanding under the circumstances and responsiveness to re-issuing the action based on the complete submission and record. Applicant will address each issue raised in turn as specifically as possible.

#### **1. Priority under 35 U.S.C. §119 (Foreign Priority) and Drawing in Application Papers**

A request is made to confirm completeness and adequacy of the priority claim on form PTOL-326, noting a secure priority chain to the instant case. It is noted that the Preliminary Amendment of December 3, 2004 and the Substitute Specification of November 7, 2005 assert the complete priority chain and the same is noted in the formal Filing Receipt. While nothing seems amiss with the drawing, a similar request is made to acknowledge the acceptance of the drawing in the record. See generally 37 C.F.R. 1.104(b). As this application is based upon a §371 filing, it remains possible that these matters did not transfer smoothly and Applicant requests confirmation.

#### **2. Completeness of the Action**

The instant action cites as a blocking reference to a foreign language reference DT1218819 to Surerus (German). Applicant presumes that a complete translation is within the possession of the Office as this is required by the completeness of the Examiner's action. Unfortunately, no form of translation was provided (complete or abstract) further to office practice (37 C.F.R. §1.104(d)) and as a consequence Applicant was initially unable to judge the propriety of continuing the prosecution of

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this application (35 USC §132) and considered requesting a complete action again. Rather than delay further prosecution, Applicants generated a complete translation for their use. While Applicant is under no obligation to provide such a translation (presumably fully within the Office), should a request be made for the translation and certification of translation thereof, the same will be provided. In the spirit of streamlined prosecution Applicant will await the Office request in this matter.

### **3. Claim Rejection under 35 USC §112, first paragraph**

The present action on page 2 suggests selected claims (specifically claims 17 and 22) lack support from the specification. Applicant respectfully traverses and requests reconsideration and withdrawal of this rejection.

Applicant is unaware of a requirement to cite where, in the originally filed application, support for each claim may be located in writing and none has been cited. MPEP §714.02 is cited as supporting the assertion of such a requirement but this reference deals with a responsiveness to actions and is not on point for the requirement asserted.

Since the claims in the present application closely match the multiple dependent claims in the originally filed application – provided as a translation on November 7, 2005 - Applicant respectfully suggests that no further specificity is required other than that provided below. Each original parent application was incorporated by reference upon the initial filing of this application and provides a substantial foundation.

The Office draws concern, to two specific claims, claim 17 and 22 and these are addressed below:

(a) Claim 17 employs the term “electrically conductive ceramic composite”. Those of skill in the art will recognize that a ceramic is an inorganic material, may be conductive and non-conductive, and may be – for example - “threads of graphite” (translation page 2, bottom para). Principal examples of ceramic use in the field are carbon fiber and glass fiber and matrices of threads of the same when used to form an external rigid shell having a light weight. For example, a carbon fiber matrix is readily understood as being made from

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graphite fibers and includes “threads of a conductive material” as used in the present case. The translation also notes the use of conductive carbon, threads of graphite, metal, “or the like.” Since the phrase “or the like” is improper to use in the claims, ceramic was selected and is without confusion. The translation clearly supports the use of a “matrix” (e.g. a “composite”) of threads of graphite or carbon and that the matrix may be of both unordered and ordered threads of a conductive material (page 2, top para.) just as would occur in a ceramic composite. As a consequence, it is proposed that support is readily located within the instant translation for “ceramic composite” and those of skill in the art having read and contemplated the same would have no confusion.

(b) Claim 22 notes a “non-distal” end of a stump as being one of a set of “distal” and “non-distal” ends for a single noun. The entire disclosure provides support to the subject matter of amputees and the drawing and discussion readily note the discussion of a “distal” end of a stump. Those of skill in the art will readily recognize the subject matter to which it pertains (for example the liner is discussed as having a distal and hence also non-distal end). It is therefore proposed that those of skill in the art will also readily recognize that by logical analysis the opposite of the “distal” end of the stump subsumes the “non-distal” end of the stump without reaching. Since those of skill in the art will also recognize that the liner covers, in part, both the distal end and the non-distal end of any limb inserted therein (see the drawing), no further discussion is believed to be necessary.

As a consequence of the above, Applicant believes they have responded to each concern raised by the Office and reconsideration and withdrawal of the present object under 35 U.S.C. §112 is respectfully requested along with notice to that effect in any subsequent office communication.

#### **4. Rejection of claims under 35 USC §101**

Claims 15-29 stand presently rejected under §101 as directed to non-statutory subject matter. Applicant respectfully traverses and requests reconsideration and withdraw of this rejection.

Applicant as been unable to locate a requirement under §101 preventing the claiming of non-body elements, and the use of language relating to the existence, shape, composition, and operative positioning thereof relative to a location or position on a body. A request is made to provide a more specific citation (35 USC §132) prohibiting such language so that Applicant may more adequately respond. For example, the claims do not require a “stump” but position other elements in the construction relative to the same for ready understanding.

Applicant notes for example in the applied reference to Flick (US 6,861,570) claim 1, cites specific elements of a medical device relative to “a body site” or “a portion of a body of a living organism.”. As this is one of the two best available references applied (37 C.F.R. §104) Applicant respectfully suggests that the language use originally provided is readily sufficient under 35 USC §101.

While traversing the present rejection for the reasons noted above, which Applicant maintains, an attempt has been made to address this matter in the present claims.

As a consequence of the above, Applicant believes they have responded to each concern raised by the Office in this matter and reconsideration and withdrawal of the present rejection is respectfully requested along with notice to that effect.

#### **5. Rejection of claims under 35 U.S.C. §102(b) and (e)**

Claims 14-29 stand presently rejected under 35 U.S.C. § 102(b) and (e) as being anticipated by respectively Surerus (DT 2329929) and Flick (S 6,861,570) without specificity as to the particular claims.

Applicant has carefully studied the Examiner’s comments. The rejection is respectfully traversed and reconsideration is requested. In order to avoid rejection for anticipation, it is only necessary to show that a claim contains at least one element, limitation, or requirement not disclosed in the single prior art reference applied.

A. Surerus '929

Regarding point 2 above, while a complete translation is necessarily available to the Office for issuance of the present action and citation on the PTO-1449 form, Applicants have acquired their own fully certified copy and will provide the same to the Examiner upon reference for the same. Since this reference is already cited on PTO-1449 no additional submission is required.

The Surerus reference notes (in the 6<sup>th</sup> and 7<sup>th</sup> full paragraphs of the original and the translation) that “stump insert 7” is a cellular material (acting as a cushion) and having “electric conductivity”. In direct contrast to this specific requirement, independent Claim 14, line 4 requires the elastomeric material be “electrically insulating”. Independent Claim 15, lines 2-3, requires that the sleeve member be elastic and an “electrically insulating material”. Claim 29 similarly requires that the sleeve member be formed from an elastic and “electrically insulating” material.

Since Surerus specifically lists the cited elastic member “stump insert 7” as being *electrically conductive* or having *electric conductivity* when contacting an inserted stump, at least one element is different from the instant independent claims and they are allowable for that reason. Therefore, it is respectfully proposed that the rejection of the instant claims for anticipation by the reference has been overcome and reconsideration is requested.

B. Flick '570

Applicant is not certain the reference to “17:37 et seq.” or 17:41 et seq.” on page 5 of the present action and requests clarification. Applicant has considered this to be a code for a column/line reference but this does not parallel the Office assertions and clarification is requested.

In contrast to the specific requirements of the instant invention, as evidenced in the independent claims, Flick '570 requires specifically for functioning that (as with Surerus) the electrically conductive material be placed in contact with the tissue (Disclosure of Invention, col. 6, lines 44-46) or with “a body site” (claim 1, lines 6-7) – or be the first operative layer on the body site- this is noted throughout.

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While Applicant agrees with the Examiner that Flick ‘570 teaches any number of “layers”, Flick ‘570 fails to appreciate and indicate the specific requirements for employing electrically insulating material adjacent the treatment location and the specific order, orientation, function, and shape (sleeve-like) of the instant claims, wherein the electrically conductive larger sleeve matrix is shielded from direct contact with the limb.

Flick notes “[t]he most important qualities of the base fiber are....being coated with a metal or metals” (col 8, lines 55-60) so as to allow electrical continuity to various controllable degrees so as to generate a capacitive effect - all in contradiction to the present claims. This arrangement is repeated throughout the reference without contradictory teaching. Flick ‘570 also fails to discuss the shape as (a) a medical prosthetic liner or (b) integration with a locking shaft, (d) liner cup member etc. Also required elements of the present invention.

Similarly, while the present claims list the inverse (electrically insulating with an electrically conductive layer external) Flick’570 fails to note the remaining elements in the dependent claims (locking means etc.)

Since Flick ‘570 specifically requires that the innermost of the multiple layers that will contact the “body” surface for the present construction be capable of *electrical conduction* or having *electric conductivity* a substantial difference exists. Consequently, having shown that at least one element in each claim is different from the instant reference, each claim is allowable for that reason as well as for the additional detail that they contain. Therefore, it is respectfully proposed that the rejection of the instant claims for anticipation by the reference has been overcome and reconsideration is requested.

C. Dependent Claims and other USC sections.

The dependent claims in the instant application have also been fully noted as anticipated by the two references. 37 C.F.R. §104 and relevant MPEP sections require the present action to have cited the best references and also that the examination is complete and that all rejections have been raised. Since the specific elements in the dependent claims were not raised, and since no other USC

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sections were cited following a full office review the same may not be raised absent improper application of the relevant codes, rules, and guidelines.

### CONCLUSION

In view of the foregoing, the application is now believed to be in proper form for allowance and notice to that effect is earnestly solicited. Reconsideration and withdrawal of the rejections is respectfully requested. Applicants propose respectfully that they have responded to each and every rejection and objection raised by the Examiner in this case.

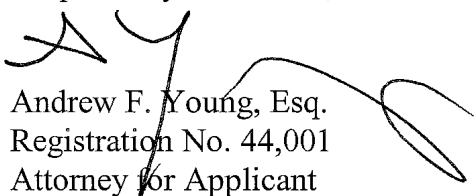
While Applicant has have respectfully disagreed with the Examiner's rejection of the claims for the above reasons, Applicant's have elected to amend the claims for clarity only, and solely for the purpose of clarifying the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG)

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 10-0100. No new matter has been added.

If the Examiner would like to discuss the present application, claims, amendments or other matters, Applicant would appreciate a courtesy call to discuss placing the application in condition for allowance.

Early and favorable action is respectfully solicited.

Respectfully Submitted,

  
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